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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,622	11/21/2003	Moshe Levnat	847-072	3492

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EXAMINER

TAMAI, KARL I

ART UNIT	PAPER NUMBER
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2834

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/719,622

Applicant(s)

LEVNAT, MOSHE

Examiner

Tamai I.E. Karl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 is rejected because "a lubricant compatible with FDA oversight" is vague and indefinite. It is unclear which lubricants are considered compatible for a sealed bearing. For the purpose of advancing prosecution on the merits, any bearing lubricant which is sealed can be considered compatible for FDA oversight since the sealed lubricant will not contact the food or medicine.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The rejection of Claims 1, 2, and 6-13 under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter is withdrawn.

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5. Claims 1, 2, 9, 10, 11, and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Perl (US 3750951). Perl teaches an electric motor having a stainless steel housing 64 that admits washing fluid to be circulated through the motor after the washing operation. The motor includes a stainless steel housing 69 and an inner stainless steel can 70 positioned between the rotor and stator and exposed to the washer water. Perl unsealed motor being drained and heat dried by operation of the motor after the wash cycle (inherently drying and protecting against failure) (col. 5, line 40). Perl teaches the bearings lubricated and sealed at 54 against the entrance of liquids (col. 3, line 65).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perl (US 3750951) and Kenny (US 6652249). Perl teaches every aspect of the invention except the motor being a permanent magnet motor or a control with a resolver or encoder. Kenny teaches wet pumps have permanent magnet rotors 87 with resolver or encoder (col 10, line 15) controls to provide an integrated, self contained, pump, motor and a control unit with is inexpensive and easy to assemble. It is would have

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been obvious to a person of ordinary skill in the art at the time of the invention to construct the motor of Perl with the motor being a permanent magnet motor or a control with a resolver or encoder because Kenny teaches the wet motor can be designed inexpensively and which is easy assemble, where the resolver or controller provides control of motor to overcome load variations.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perl (US 3750951). Perl teaches every aspect of the invention except the bearings lubricated with a lubricant compatible with FDA oversight. It is would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the motor of Perl with the bearings lubricated with a lubricant compatible with FDA oversight because selection of the material based on intended use is within the ordinary skill in the art (*In re Leshin*, 125 USPQ 416), and because the residual lubricants may leak from an old oil seal and be deposited on the dishes being cleaned by the dish washer.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perl (US 3750951) and Selders (Electric Motors – Lubrication and Cleaning). Perl teaches every aspect of the invention except periodically removing the motor to be cleaned. Selders teaches disassembly of the motorized device to provide a through cleaning. It is would have been obvious to a person of ordinary skill in the art at the time of the invention to remove the motor of Perl from the apparatus prior to cleaning to clean foreign matter from the motor, as taught by Selders.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 11-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-12 of application number 10/719,768 in further view of Perl (US 3750951). Claims 11-13 of the current application of the same as claims 10-12 of the copending application (10/719,768) except the current claims require an electric motor with stainless steel exposed surfaces and a stainless steel housing. Perl teaches both a stainless steel housing 64 and a motor with a stainless steel can 70 between the rotor and the stator. It would have been obvious to make the claimed motor of copending application 10/719,768 with the stainless steel components of Perl to allow thermal dissipation from the motor to the pumped fluid as taught by Perl.

Response to Arguments

12. Applicant's arguments filed 10/4/2006 have been fully considered but they are not persuasive.

Applicant's argument regarding vague and indefinite limitation of claim 10 is not persuasive. The limitation of "a lubricant compatible with FDA oversight" is vague and indefinite. The claim is not clear as to what lubricant is compatible with FDA oversight. The applicant's arguments that the specification discloses ThermaPlex is not persuasive, because limitations from the specification are not read into the claims. Applicant's cited reference regarding LPS Laboratories oil is not persuasive, because it refers to incidental food contact regulations, but it is unclear whether "compatible" in the claims limits the lubricant an oil that may have incidental contact with the food or a machine that not does not have any contact with food, but is still subject to FDA oversight because it is used in the food industry. The claims if vague and indefinite because regulations change with time, such it is unclear if the claim limitations are include a lubricant for compatible with the regulations written as of the date of the invention or 10 years from now. The Applicant's argument that the examiner read out a limitation from the claim is not persuasive, that is a matter of broad interpretation when applying the prior art, not whether the claim is definite. The claim limitation is vague and indefinite, and the rejection is proper.

Applicant's argument regarding the unsealed washable electric motor assembly being a structural limitation is persuasive. The limitation was addressed in the prior

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office action. Perl shows an unsealed motor, where the motor is washed when water is flushed through the motor. Dishwashers wash dishes which is a use in food preparation and subject to FDA oversight, thus Perl reads on the preamble. Additionally the limitation of "for use in the food and medicine preparation subject to FDA oversight" is **clearly** an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The only structural limitations that are recited in the preamble is an unsealed motor that is flushed with water. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant application, the motor of Perl is unsealed and flushed with water. Furthermore, a dishwasher motor is capable and is used in the preparation of food which is subject to FDA oversight". The caselaw supports the examiner's position in *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) holding that the recitation preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The structural limitations of the preamble stand alone are were properly addressed in the prior office action. The rejection is proper and maintained.

Applicant's argument that "clean" requires sterilization is not persuasive because the limitation is not claimed. Applicant's argument that the motor must be cleaned in a separate step from the food or medicine preparation is not persuasive because the limitation is not claimed.

Applicant's argument that Perl does not teach drying of the motor by operation of the motor (claim 2) is not persuasive. Perl teaches in col. 5, lines 38-45 that the water drained from the dishwasher, including the motor, and the motor is energized to assist in the drying cycle and where the impellar 81 on the bottom of the motor is assisting in the circulation of the air through out the enclosure. Perl specifically teaches flushing the motor with water, draining the water, then operating the motor once the water is removed. The Applicant's arguments about humidity and the drying of the dishes is not persuasive because Perl specifically teaches the claimed limitation of operating the motor after the water is drained, as set forth in claim 2.

Applicant's argument that there is no motivation to combine Kenny with Perl is not persuasive. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Kenny provides literal motivation in that permanent magnet motors with encoders provide low cost control and a wide range of speeds (columns 9-10). Applicant's argument that Kenny is a fuel

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pump is not persuasive because both are fluid pumps, and Kenny provide the motivation to combine the references.

Applicant's argument regarding claim 10 is not persuasive. The requirements of 35 USC 112 require the claims to particularly point out and distinctly claim the Applicant's invention. The claim is considered vague and indefinite when the claim language does not particularly and distinctly claim the invention. The analysis for applying prior art is a separate matter which requires the broadest reasonable interpretation of the claims. In the instant application, the indefiniteness of the claims leads to the confusion. Perl teaches the bearings 50 sealed by 54. Perl does not teach the lubricant for the bearings being compatible with FDA oversight, however selection of the material based on intended use has been held to be within the ordinary skill in the art (see *In re Leshin*, 125 USPQ 416). It is possible that the bearings of Perl could leak, and leave residue on the cleaned dishes, which would have incidental contact with food, thus subject to FDA regulation 21 CFR 178.3570. Therefore, it is obvious in the name of uses a lubricant that is acceptable for incidental food contact in a device which is used in the food industry.

Applicant's arguments regarding the disassembly of the device for cleaning is not persuasive. Sellers clearly teaches, provides literal motivation, that the motor should be periodically cleaned by disassembling the motor to removed any dirt or foreign matter (page 2, third paragraph). The Applicant's argument that disassembly of the motor is not removal of the motor from the dishwasher is merely semantics. The combined teaches of Perl and Sellers together teach the motor should be cleaned and inspected

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by disassembly, where the disassembly of Perl clearly suggest that the motor is removed from the dishwasher. It would be difficult to clean out any dirt and foreign matter from the motor without removing the motor from the dishwashing tub.

Applicant's arguments regarding the lubricant's of Sellers is not persuasive because the type of lubricant is not claimed. Applicant's arguments about use in the food and medicine preparation is not persuasive because it is merely intended use.

The Applicant's arguments regarding the double patenting rejection is persuasive and will prevent a 35 USC 103 rejection over application 10/719,768 if a patent ever issues. The arguments do not overcome the non-statutory double patenting rejection which may be overcome by a terminal disclaimer.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl I.E. Tamai whose telephone number is (571) 272 - 2036.

The examiner can be normally contacted on Monday through Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg, can be reached at (571) 272 - 2044. The facsimile number for the Group is (571) 273 - 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karl I Tamai
PRIMARY PATENT EXAMINER
December 13, 2006



KARL TAMAI
PRIMARY EXAMINER